



AP
JFW

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/732,024
	Filing Date	December 8, 2000
	First Named Inventor	Newman, Paula S.
	Art Unit	2144
	Examiner Name	Thanh Nguyen
Total Number of Pages in This Submission	Attorney Docket Number	A0836

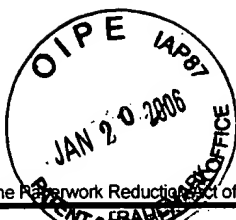
ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to (TC)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Law Offices of Patrick J.S. Inouye	
Signature		
Printed name	Patrick J.S. Inouye	
Date	January 17, 2006	Reg. No. 40297

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.		
Signature		
Typed or printed name	Larissa V. Pigott	Date January 17, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

In you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PTO/SB/17 (12-04)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL For FY 2005		Complete if Known	
		Application Number	09/732,024
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). Effective on 12/8/2004.		Filing Date	December 8, 2000
		First Named Inventor	Newman, Paula S.
		Examiner Name	Thanh Nguyen
		Art Unit	2144
<input type="checkbox"/> Applicant Claims small entity status. See 37 CFR 1.27		Attorney Docket No.	A0836
TOTAL AMOUNT OF PAYMENT		(\$)	500.00

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 24-0037 Deposit Account Name: Xerox Corporation

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charges fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
- 20 or HP =	x	=		Fee (\$) Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	x	=	

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41 (a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other: Appeal Brief Fee: \$500.00**Fees Paid (\$)**
500.00**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	40297	Telephone	(206) 381-3900
Name (Print/Type)	Patrick J.S. Inouye	Date	January 17, 2006		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

TABLE OF CONTENTS

	1.	REAL PARTY IN INTEREST	3
	2.	RELATED APPEALS AND INTERFERENCES.....	3
	3.	STATUS OF CLAIMS	3
5	4.	STATUS OF AMENDMENTS	3
	5.	SUMMARY OF CLAIMED SUBJECT MATTER	3
	A.	Independent Claim 1	3
	B.	Independent Claim 10	4
	C.	Independent Claim 18	5
10	D.	Independent Claim 26	6
	6.	GROUND FOR REJECTION TO BE REVIEWED ON APPEAL	7
	A.	Issue I	7
	7.	ARGUMENT	7
	A.	Issue I	7
15	1.	Legal Basis	7
	2.	U.S. Patent No. 6,484,196 issued to Maurille.....	8
	3.	U.S. Patent No. 6,044,395 issued to Costales	8
	4.	Claims 1 and 3-9	9
	5.	Claims 10 and 12-17	12
20	6.	Claims 18 and 20-25	15
	7.	Claims 26-27	19
	10.	CLAIMS APPENDIX.....	23
	11.	EVIDENCE APPENDIX.....	28
	12.	RELATED PROCEEDINGS APPENDIX	29
25			

1. REAL PARTY IN INTEREST

The real party in interest is assignee Xerox Corporation, a New York corporation, located at 800 Long Ridge Road, P.O. Box 1600, Stamford, CT 06904-1600.

5 **2. RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences known to Appellant, Appellant's legal counsel, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal

3. STATUS OF CLAIMS

10 Claims 1, 3-10, 12-18, and 20-27 are rejected and pending, which are also the subject of this appeal. An Appendix setting forth the Claims on appeal is included as Section 10, *infra*.

4. STATUS OF AMENDMENTS

15 No amendments were filed subsequent to the final rejection of Claims 1, 3-10, 12-18, and 20-27. Claims 1, 10, 18 and 26 were previously amended and Claims 2, 11, and 19 were canceled in an Amendment and Response to Office Action, filed on January 7, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 1

20 Claim 1 defines a method for presenting email threads (p. 6, lines 1-5; p. 9, line 20-p. 10, line 23). The logical components of each message in a thread are identified (p. 6, lines 6-10), which includes dividing the message into a main body and excerpts from other messages that are either embedded in the main body or suffixed, as well as decomposing these sections into group types, such as text-
25 blocks, tables, contact information, and the like. The relationships between the messages in the thread are determined using the logical components (p. 7, line 31-

p. 8, line 15), which uses the logical components to match excerpts with their sources and to identify predecessor or predecessors for each message. If possible, each excerpt is matched to its source. Otherwise, predecessors are found based on a combination of evidence, including header fields, header fields of included messages, excerpted text, and the like. A document based upon the determined relationships is generated, wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated document does not include the redundant logical components (p. 8, line 16-p. 9, line 19). In a first presentation technique, messages are presented in a semi-linear message sequence in which embedded quotes are abbreviated, included messages are eliminated and links are provided to allow full access to the quotes (p. 4, lines 4-7; p. 5, lines 29-31). In a second presentation technique, blocks are presented that constitute responses to a particular passage as annotations to the passage in the original message via in-lining, margin text, framing, links or other similar display strategies (p. 4, lines 7-9; p. 5, lines 31-34).

B. Independent Claim 10

Claim 10 defines a computer controlled display system (p. 6, lines 1-5; p. 10, line 25-p. 11, line 14). A display is configured for presenting e-mail threads on a viewing area of the display (p. 10, line 25-p. 11, line 14). A processor is adapted to identify the logical components of each message in a thread (p. 6, lines 6-10), which includes dividing the message into a main body and excerpts from other messages that are either embedded in the main body or suffixed, as well as decomposing these sections into group types, such as text-blocks, tables, contact information, and the like. The processor is further adapted to determine the relationships between each message in the thread using the logical components (p. 7, line 31-p. 8, line 15), which uses the logical components to match excerpts with their sources and to identify predecessor or predecessors for each message. If possible, each excerpt is matched to its source. Otherwise, predecessors are found based on a combination of evidence, including header

fields, header fields of included messages, excerpted text, and the like. The processor is further adapted to generate a medium, such as a display, based upon the determined relationships, wherein the processor is adapted to remove any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components (p. 8, line 16-p. 9, line 19). In a first display, messages are presented in a semi-linear message sequence in which embedded quotes are abbreviated, included messages are eliminated and links are provided to allow full access to the quotes (p. 4, lines 4-7; p. 5, lines 29-31; p. 10, lines 25-28). In a second display, blocks are presented that constitute responses to a particular passage as annotations to the passage in the original message via in-lining, margin text, framing, links or other similar display strategies (p. 4, lines 7-9; p. 5, lines 31-34; p. 10, line 28-p. 11, line 14).

C. Independent Claim 18

Claim 18 defines an information storage media (p. 5, lines 1-22; p. 6, lines 1-5). The information presents e-mail threads on a viewing area of a display (p. 10, line 25-p. 11, line 14). The information further identifies the logical components of each of the messages in a thread (p. 6, lines 6-10), which includes dividing the message into a main body and excerpts from other messages that are either embedded in the main body or suffixed, as well as decomposing these sections into group types, such as text-blocks, tables, contact information, and the like. The information further determines relationships between each of the messages in the thread using the logical components (p. 7, line 31-p. 8, line 15), which uses the logical components to match excerpts with their sources and to identify predecessor or predecessors for each message. If possible, each excerpt is matched to its source. Otherwise, predecessors are found based on a combination of evidence, including header fields, header fields of included messages, excerpted text, and the like. The information further generates a medium based upon the determined relationships (p. 8, line 16). The information

further removes any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components (p. 8, line 17-p. 9, line 19). In a first presentation technique, messages are presented in a semi-linear message sequence in which
5 embedded quotes are abbreviated, included messages are eliminated and links are provided to allow full access to the quotes (p. 4, lines 4-7; p. 5, lines 29-31). In a second presentation technique, blocks are presented that constitute responses to a particular passage as annotations to the passage in the original message via in-lining, margin text, framing, links or other similar display strategies (p. 4, lines 7-
10 9; p. 5, lines 31-34).

D. Independent Claim 26

Claim 26 defines a computer system for presenting email threads comprising a computer processor (p. 5, lines 1-22; p. 6, lines 1-5). Logical components of each message in a thread are identified (p. 6, lines 6-10), which
15 includes dividing the message into a main body and excerpts from other messages that are either embedded in the main body or suffixed, as well as decomposing these sections into group types, such as text-blocks, tables, contact information, and the like. Relationships between the messages in the thread using the logical components are determined (p. 7, line 31-p. 8, line 15), which uses the logical
20 components to match excerpts with their sources and to identify predecessor or predecessors for each message. If possible, each excerpt is matched to its source. Otherwise, predecessors are found based on a combination of evidence, including header fields, header fields of included messages, excerpted text, and the like. A medium is generated based upon the determined relationships, wherein the e-mail
25 threads are presented in the medium as semi-connected text, and wherein any logical components that are identified in each of the messages in the thread are removed during the generating step so that the generated medium does not include the redundant logical components (p. 8, line 16-p. 9, line 19). In a first presentation technique, messages are presented in a semi-linear message sequence

in which embedded quotes are abbreviated, included messages are eliminated and links are provided to allow full access to the quotes (p. 4, lines 4-7; p. 5, lines 29-31). In a second presentation technique, blocks are presented that constitute responses to a particular passage as annotations to the passage in the original message via in-lining, margin text, framing, links or other similar display strategies (p. 4, lines 7-9; p. 5, lines 31-34).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

A. Issue I

Whether Claims 1, 3-10, 12-18, and 20-27 stand properly rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,484,196 to Maurille (“Maurille”) in view of U.S. Patent No. 6,044,395 to Costales et al. (“Costales”). The rejected claims do not stand or fall together. Accordingly, the rejections of Claims 1 and 3-9, 10 and 12-17, 18 and 20-25, and 26-27 are argued separately.

7. ARGUMENT

15 A. Issue I

Whether Claims 1, 3-10, 12-18, and 20-27 stand properly rejected under 35 U.S.C. § 103(a) as being obvious over Maurille and in view of Costales.

1. Legal Basis

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the examiner has the burden of proving that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there is a reasonable expectation of success; and (3) the combined references teach or suggest all the claim limitations. MPEP § 2143. A *prima facie* of obviousness case has not been shown. Appellant traverses the rejection.

2. U.S. Patent No. 6,484,196 issued to Maurille

The Maurille reference discloses communications board system with multiple modes that can be variously configured, including a threaded mail system that allows a user to send threaded email over the Internet (Col. 2, line 55-
5 Col. 3, line 1; Col. 6, lines 40-41). A sender requests communication services using a client application that relays the request to a server program, which moderates all communications activities and updates a message repository to reflect the request (Col. 3, lines 3-15). A sender sends a message to a recipient by filling in a send message template and, upon receiving the message information,
10 the server stores the pertinent information in a message table and updates message status fields and threading information (Col. 3, lines 29-37). The threading information enables the client application to display the message's history, along with that of other messages (Col. 3, lines 61-63), and includes a thread identifier generated by the server application, subject completed by the sender, and a sort
15 number for the subject (Col. 10, lines 56-60). A thread includes a first level message and subsequent replies, which can be added to the thread until the thread is closed by an explicit acknowledgment issued by a thread participant (Col. 9, lines 1-4). An initial message is assumed to be a first level message that starts a new thread of conversation (Col. 10, lines 2-4).

20 3. U.S. Patent No. 6,044,395 issued to Costales

The Costales reference discloses a method and apparatus for distributing personalized email, which contains a message body for any given recipient that is identical for all recipients, but contains other portions of the message body that are unique for each recipient (Col. 2, lines 12-17). A first portion of an email
25 message is sent, which contains one or more blocks of text that are each assigned different index values (Col. 2, lines 50-53). A second portion of the email message is sent, which contains information specific to a particular recipient and contains pointers to the index values (Col. 2, lines 53-57). The first and second portions together include information sufficient to form a complete personalized

email message for a particular recipient (Col. 2, lines 57-59).

4. Claims 1 and 3-9

The first prong of *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Initially, the examiner must show some teaching or suggestion to combine references that supports their use in combination. *See, Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such teaching or suggestion has not been shown.

10 Maurille teaches a multimodal communications board system that includes a threaded email system. Prior to sending a message, senders must fill out a message template and a message server uses the message information to perform a sequence of operations to update a messages table, including updating message status fields and threading information. *See, e.g., Maurille*, Col. 10, line 18-Col. 15 11, line 7. The messages table identifies the name of a file that contains message body text, a user name of a message recipient, a comma delimited list of recipients, and a comma delimited list of carbon copy recipients. *Id.* at Col. 8, lines 29-47.

In contrast, Costales teaches a personalized email distribution system and 20 method that attempts to avoid burdening available computing resources with high volume personalized email transmissions. *Costales*, Col. 2, lines 25-30. A client can send an individual email message or a common content “chunk,” that is, information common to multiple email messages, plus pointers referencing the content chunks. *Id.* at Col. 4, lines 28-39. The client may send multiple 25 messages, which each reference a content chunk that is transmitted only once, and the server, based on the pointers, inserts appropriate content chunks to create individual personalized email messages. *Id.* at Col. 4, lines 39-44

Both Maurille and Costales teach person-to-person email that can be sent from one sender to one recipient or to many recipients. However, the message

server taught by Maurille moderates all communications activities, including storing the name of a file that contains message body text and tracking individual senders and recipients for use as threading information. Maurille fails to provide a suggestion or motivation to be modified or combined with the personalized email distribution teachings of Costales, in which the message body text for each recipient can be indirectly specified through index values, instead of message body text as taught by Maurille. Moreover, Costales teaches away from Maurille by disallowing the tracking of threads. In Maurille, the threading information allows a client application to display a message's history, including any subsequent replies. In Costales, each personalized email message is different and constitutes a *separate and distinct* thread that originated from the same sender as each of the other personalized email messages. Maurille, though, fails to teach or suggest tracking multiple parallel threads for the same originating sender. As a result, one of ordinary skill in the art would not be motivated to modify or combine the teachings of Maurille and Costales, as the ability to track threads would be lost.

The second prong of *prima facie* obviousness requires a reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Although both Maurille and Costales teach conventional person-to-person email, modifying or combining the teachings of Maurille and Costales would disallow the tracking and use of threading information. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

The third prong of *prima facie* obviousness requires that the combined references teach or suggest all the claim limitations. Claim 1 defines a method for presenting email threads. Maurille teaches using threading information that is updated by the message server moderating the communications activities between

the sender and the recipient, such that the relationships between all messages are progressively tracked. In contrast, Claim 1 recites *identifying* the logical components of each message in a thread and *determining* the relationships between the messages in the thread using the logical components, which is neither taught nor suggested by Maurille, in which threading information is expressly updated and stored as part of message relaying. In addition, Maurille teaches displaying messages with full threading information as relayed by the message server. *See, Maurille*, FIGURE 4B. In contrast, Claim 1 further recites *generating* a document based upon the determined relationships, which is neither taught nor suggested by Maurille, which displays a set of messages as sent using stored threading information. Finally, Costales teaches sending a first portion of an email message that contains one or more blocks of text with assigned index values and a second portion, which contains recipient-specific information and pointers to the index values. In contrast, Claim 1 further recites that any logical components that are identified in each of the messages in the thread are *removed* during the generating step so that the generated document does not include the redundant logical components, which is neither taught nor suggested by Costales, which inserts, not removes text blocks that would otherwise be redundant if sent as separate email messages. Consequently, the combined references fail to teach or suggest all the claim limitations.

The required showing to establish a *prima facie* of obviousness has not been met. There is no showing as to why one of ordinary skill in the art would have felt a suggestion or motivation to modify or combine the reference teachings of Maurille and Costales. The final Office action provides, “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Costales into the computer system of Maurille to have generated document does not include the redundant logical components because it would have provided the quality of systems or elements that are backed up with secondary resources.” Final Off. Act., p. 3, first para. There are no such teachings or suggestions in either Maurille or Costales. Finding similar elements

in one or more references does not automatically render an invention unpatentable, nor may the invention be used as an instruction book on how to reconstruct the invention from the art references. *See Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

5 Thus, a *prima facie* case of obviousness has not been shown with respect to Claim 1. Claims 3-9 are dependent on Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. As a *prima facie* case of obviousness has not been shown, withdrawal of the rejection of Claims 1 and 3-9 for obviousness under 35 U.S.C. 103(a) is
10 respectfully requested.

5. Claims 10 and 12-17

 The first prong of *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the
15 reference teachings. Initially, the examiner must show some teaching or suggestion to combine references that supports their use in combination. *See, Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such teaching or suggestion has not been shown.

 Maurille teaches a multimodal communications board system that includes
20 a threaded email system. Prior to sending a message, senders must fill out a message template and a message server uses the message information to perform a sequence of operations to update a messages table, including updating message status fields and threading information. *See, e.g., Maurille*, Col. 10, line 18-Col. 11, line 7. The messages table identifies the name of a file that contains message
25 body text, a user name of a message recipient, a comma delimited list of recipients, and a comma delimited list of carbon copy recipients. *Id.* at Col. 8, lines 29-47.

 In contrast, Costales teaches a personalized email distribution system and method that attempts to avoid burdening available computing resources with high

volume personalized email transmissions. *Costales*, Col. 2, lines 25-30. A client can send an individual email message or a common content “chunk,” that is, information common to multiple email messages, plus pointers referencing the content chunks. *Id.* at Col. 4, lines 28-39. The client may send multiple
5 messages, which each reference a content chunk that is transmitted only once, and the server, based on the pointers, inserts appropriate content chunks to create individual personalized email messages. *Id.* at Col. 4, lines 39-44

Both Maurille and Costales teach person-to-person email that can be sent from one sender to one recipient or to many recipients. However, the message
10 server taught by Maurille moderates all communications activities, including storing the name of a file that contains message body text and tracking individual senders and recipients for use as threading information. Maurille fails to provide a suggestion or motivation to be modified or combined with the personalized email distribution teachings of Costales, in which the message body text for each
15 recipient can be indirectly specified through index values, instead of message body text as taught by Maurille. Moreover, Costales teaches away from Maurille by disallowing the tracking of threads. In Maurille, the threading information allows a client application to display a message’s history, including any subsequent replies. In Costales, each personalized email message is different and
20 constitutes a *separate and distinct* thread that originated from the same sender as each of the other personalized email messages. Maurille, though, fails to teach or suggest tracking multiple parallel threads for the same originating sender. As a result, one of ordinary skill in the art would not be motivated to modify or combine the teachings of Maurille and Costales, as the ability to track threads
25 would be lost.

The second prong of *prima facie* obviousness requires a reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of
30 what such reference fairly suggests to one of ordinary skill in the art. *Bausch &*

Lomb, Inc. v. Barnes-Hind, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Although both Maurille and Costales teach conventional person-to-person email, modifying or combining the teachings of Maurille and Costales would disallow the tracking and use of threading information. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

The third prong of *prima facie* obviousness requires that the combined references teach or suggest all the claim limitations. Claim 10 defines a computer controlled display system. Maurille teaches using threading information that is updated by the message server moderating the communications activities between the sender and the recipient, such that the relationships between all messages are progressively tracked. In contrast, Claim 10 recites a processor that is adapted to *identify* the logical components of each message in a thread and to *determine* the relationships between each message in the thread using the logical components, which is neither taught nor suggested by Maurille, in which threading information is expressly updated and stored as part of message relaying. In addition, Maurille teaches displaying messages with full threading information as relayed by the message server. *See, Maurille*, FIGURE 4B. In contrast, Claim 10 recites a processor that is further adapted to *generate* a medium based upon the determined relationships, which is neither taught nor suggested by Maurille, which displays a set of messages as sent using stored threading information. Finally, Costales teaches sending a first portion of an email message that contains one or more blocks of text with assigned index values and a second portion, which contains recipient-specific information and pointers to the index values. In contrast, Claim 10 recites a processor that is further adapted to *remove* any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components, which is neither taught nor suggested by Costales, which inserts, not removes text blocks that would otherwise be redundant if sent as separate email messages. Consequently, the combined references fail to teach or suggest all the claim limitations.

The required showing to establish a *prima facie* of obviousness has not

been met. There is no showing as to why one of ordinary skill in the art would have felt a suggestion or motivation to modify or combine the reference teachings of Maurille and Costales. The final Office action provides, “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to
5 implement the teachings of Costales into the computer system of Maurille to have generated document does not include the redundant logical components because it would have provided the quality of systems or elements that are backed up with secondary resources.” Final Off. Act., p. 3, first para. There are no such teachings or suggestions in either Maurille or Costales. Finding similar elements
10 in one or more references does not automatically render an invention unpatentable, nor may the invention be used as an instruction book on how to reconstruct the invention from the art references. *See Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Thus, a *prima facie* case of obviousness has not been shown with respect
15 to Claim 10. Claims 12-17 are dependent on Claim 10 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. As a *prima facie* case of obviousness has not been shown, withdrawal of the rejection of Claims 10 and 12-17 for obviousness under 35 U.S.C. 103(a) is respectfully requested.

20 6. Claims 18 and 20-25

The first prong of *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Initially, the examiner must show some teaching or
25 suggestion to combine references that supports their use in combination. *See, Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such teaching or suggestion has not been shown.

Maurille teaches a multimodal communications board system that includes a threaded email system. Prior to sending a message, senders must fill out a

message template and a message server uses the message information to perform a sequence of operations to update a messages table, including updating message status fields and threading information. *See, e.g., Maurille*, Col. 10, line 18-Col. 11, line 7. The messages table identifies the name of a file that contains message body text, a user name of a message recipient, a comma delimited list of recipients, and a comma delimited list of carbon copy recipients. *Id.* at Col. 8, lines 29-47.

In contrast, Costales teaches a personalized email distribution system and method that attempts to avoid burdening available computing resources with high volume personalized email transmissions. *Costales*, Col. 2, lines 25-30. A client can send an individual email message or a common content “chunk,” that is, information common to multiple email messages, plus pointers referencing the content chunks. *Id.* at Col. 4, lines 28-39. The client may send multiple messages, which each reference a content chunk that is transmitted only once, and the server, based on the pointers, inserts appropriate content chunks to create individual personalized email messages. *Id.* at Col. 4, lines 39-44

Both Maurille and Costales teach person-to-person email that can be sent from one sender to one recipient or to many recipients. However, the message server taught by Maurille moderates all communications activities, including storing the name of a file that contains message body text and tracking individual senders and recipients for use as threading information. Maurille fails to provide a suggestion or motivation to be modified or combined with the personalized email distribution teachings of Costales, in which the message body text for each recipient can be indirectly specified through index values, instead of message body text as taught by Maurille. Moreover, Costales teaches away from Maurille by disallowing the tracking of threads. In Maurille, the threading information allows a client application to display a message’s history, including any subsequent replies. In Costales, each personalized email message is different and constitutes a *separate and distinct* thread that originated from the same sender as each of the other personalized email messages. Maurille, though, fails to teach or

suggest tracking multiple parallel threads for the same originating sender. As a result, one of ordinary skill in the art would not be motivated to modify or combine the teachings of Maurille and Costales, as the ability to track threads would be lost.

5 The second prong of *prima facie* obviousness requires a reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch &*
10 *Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Although both Maurille and Costales teach conventional person-to-person email, modifying or combining the teachings of Maurille and Costales would disallow the tracking and use of threading information. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

15 The third prong of *prima facie* obviousness requires that the combined references teach or suggest all the claim limitations. Claim 18 defines an information storage media. Maurille teaches using threading information that is updated by the message server moderating the communications activities between the sender and the recipient, such that the relationships between all messages are
20 progressively tracked. In contrast, Claim 18 recites information that *identifies* the logical components of each of the messages in a thread and information that *determines* relationships between each of the messages in the thread using the logical components, which is neither taught nor suggested by Maurille, in which threading information is expressly updated and stored as part of message relaying.
25 In addition, Maurille teaches displaying messages with full threading information as relayed by the message server. *See, Maurille*, FIGURE 4B. In contrast, Claim 18 further recites information that *generates* a medium based upon the determined relationships, which is neither taught nor suggested by Maurille, which displays a set of messages as sent using stored threading information. Finally, Costales
30 teaches sending a first portion of an email message that contains one or more

blocks of text with assigned index values and a second portion, which contains recipient-specific information and pointers to the index values. In contrast, Claim 18 further recites information that *removes* any logical components that are identified in each of the messages in the thread so that the generated medium does not include the redundant logical components, which is neither taught nor suggested by Costales, which inserts, not removes text blocks that would otherwise be redundant if sent as separate email messages. Consequently, the combined references fail to teach or suggest all the claim limitations.

The required showing to establish a *prima facie* of obviousness has not been met. There is no showing as to why one of ordinary skill in the art would have felt a suggestion or motivation to modify or combine the reference teachings of Maurille and Costales. The final Office action provides, “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Costales into the computer system of Maurille to have generated document does not include the redundant logical components because it would have provided the quality of systems or elements that are backed up with secondary resources.” Final Off. Act., p. 3, first para. There are no such teachings or suggestions in either Maurille or Costales. Finding similar elements in one or more references does not automatically render an invention unpatentable, nor may the invention be used as an instruction book on how to reconstruct the invention from the art references. *See Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Thus, a *prima facie* case of obviousness has not been shown with respect to Claim 18. Claims 20-25 are dependent on Claim 18 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. As a *prima facie* case of obviousness has not been shown, withdrawal of the rejection of Claims 18 and 20-25 for obviousness under 35 U.S.C. 103(a) is respectfully requested.

7. Claims 26-27

The first prong of *prima facie* obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Initially, the examiner must show some teaching or suggestion to combine references that supports their use in combination. *See, Ashland Oil, Inc. v. Delta Resins & Refracs., Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such teaching or suggestion has not been shown.

Maurille teaches a multimodal communications board system that includes a threaded email system. Prior to sending a message, senders must fill out a message template and a message server uses the message information to perform a sequence of operations to update a messages table, including updating message status fields and threading information. *See, e.g., Maurille*, Col. 10, line 18-Col. 11, line 7. The messages table identifies the name of a file that contains message body text, a user name of a message recipient, a comma delimited list of recipients, and a comma delimited list of carbon copy recipients. *Id.* at Col. 8, lines 29-47.

In contrast, Costales teaches a personalized email distribution system and method that attempts to avoid burdening available computing resources with high volume personalized email transmissions. *Costales*, Col. 2, lines 25-30. A client can send an individual email message or a common content “chunk,” that is, information common to multiple email messages, plus pointers referencing the content chunks. *Id.* at Col. 4, lines 28-39. The client may send multiple messages, which each reference a content chunk that is transmitted only once, and the server, based on the pointers, inserts appropriate content chunks to create individual personalized email messages. *Id.* at Col. 4, lines 39-44

Both Maurille and Costales teach person-to-person email that can be sent from one sender to one recipient or to many recipients. However, the message server taught by Maurille moderates all communications activities, including storing the name of a file that contains message body text and tracking individual

senders and recipients for use as threading information. Maurille fails to provide a suggestion or motivation to be modified or combined with the personalized email distribution teachings of Costales, in which the message body text for each recipient can be indirectly specified through index values, instead of message
5 body text as taught by Maurille. Moreover, Costales teaches away from Maurille by disallowing the tracking of threads. In Maurille, the threading information allows a client application to display a message's history, including any subsequent replies. In Costales, each personalized email message is different and constitutes a *separate and distinct* thread that originated from the same sender as
10 each of the other personalized email messages. Maurille, though, fails to teach or suggest tracking multiple parallel threads for the same originating sender. As a result, one of ordinary skill in the art would not be motivated to modify or combine the teachings of Maurille and Costales, as the ability to track threads would be lost.

15 The second prong of *prima facie* obviousness requires a reasonable expectation of success. Obviousness may not be established by picking and choosing from an art reference only so much of the reference as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Bausch &*
20 *Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Although both Maurille and Costales teach conventional person-to-person email, modifying or combining the teachings of Maurille and Costales would disallow the tracking and use of threading information. Thus, one of ordinary skill in the art would have no reasonable expectation of success.

25 The third prong of *prima facie* obviousness requires that the combined references teach or suggest all the claim limitations. Claim 26 defines a computer system for presenting email threads. Maurille teaches using threading information that is updated by the message server moderating the communications activities between the sender and the recipient, such that the relationships between
30 all messages are progressively tracked. In contrast, Claim 26 recites (a)

identifying logical components of each message in a thread; and (b) *determining* relationships between the messages in the thread using the logical components, which is neither taught nor suggested by Maurille, in which threading information is expressly updated and stored as part of message relaying. In addition, Maurille teaches displaying messages with full threading information as relayed by the message server. *See, Maurille*, FIGURE 4B. In contrast, Claim 26 further recites (c) *generating* a medium based upon the determined relationships, wherein the e-mail threads are presented in the medium as semi-connected text, which is neither taught nor suggested by Maurille, which displays a set of messages as sent using stored threading information. Finally, Costales teaches sending a first portion of an email message that contains one or more blocks of text with assigned index values and a second portion, which contains recipient-specific information and pointers to the index values. In contrast, Claim 26 further recites that any logical components that are identified in each of the messages in the thread are *removed* during the generating step so that the generated medium does not include the redundant logical components, which is neither taught nor suggested by Costales, which inserts, not removes text blocks that would otherwise be redundant if sent as separate email messages. Consequently, the combined references fail to teach or suggest all the claim limitations.

The required showing to establish a *prima facie* of obviousness has not been met. There is no showing as to why one of ordinary skill in the art would have felt a suggestion or motivation to modify or combine the reference teachings of Maurille and Costales. The final Office action provides, “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Costales into the computer system of Maurille to have generated document does not include the redundant logical components because it would have provided the quality of systems or elements that are backed up with secondary resources.” Final Off. Act., p. 3, first para. There are no such teachings or suggestions in either Maurille or Costales. Finding similar elements in one or more references does not automatically render an invention

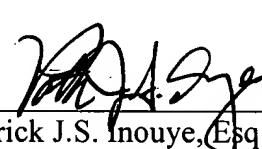
unpatentable, nor may the invention be used as an instruction book on how to reconstruct the invention from the art references. *See Panduit Corp. v. Dennison, Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Thus, a *prima facie* case of obviousness has not been shown with respect to Claim 26. Claim 27 is dependent on Claim 26 and is patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. As a *prima facie* case of obviousness has not been shown, withdrawal of the rejection of Claims 26 and 27 for obviousness under 35 U.S.C. 103(a) is respectfully requested.

In view of the foregoing arguments, Appellant respectfully submits that the rejections under 35 U.S.C. § 103(a) cannot be maintained and should be withdrawn. A Notice of Allowance is earnestly solicited. Appellant's undersigned attorney can be reached at (206) 381-3900. The Appeal Brief fee is included with the Appeal Brief

Dated: January 17, 2006

By: _____


Patrick J.S. Inouye, Esq.
Reg. No. 40,297

Law Offices of Patrick J.S. Inouye
810 Third Avenue
Suite 258
Seattle, WA 98104

Telephone: (206) 381-3900
Facsimile: (206) 381-3999

Appeal Brief

10. CLAIMS APPENDIX

1 1. (previously presented): A method for presenting email threads,
2 comprising the steps of:
3 identifying the logical components of each message in a thread;
4 determining the relationships between the messages in the thread using the
5 logical components; and
6 generating a document based upon the determined relationships,
7 wherein any logical components that are identified in each of the messages
8 in the thread are removed during the generating step so that the generated
9 document does not include the redundant logical components.

1 2. (canceled).

2 3. (original): The method of claim 1, wherein the step of identifying
3 logical components comprises generating a message tree that includes nodes that
4 recursively divide each of the messages into a main body, nested excerpts from
5 other messages, and at least one subdivision wherein each subdivision is divided
6 into lowest-level logical components.

1 4. (original): The method of claim 3, wherein the step of generating a
2 message tree comprises:
3 performing a top-down, recursive descent analysis to recursively divide
4 each of the messages into sections, each section being one of a main-body of the
5 message, an incorporated excerpt, a suffixed excerpt, the body of an excerpt, and
6 an excerpt within an excerpt; and
7 decomposing each section into logical components using a weighted
8 finite-state machine.

1 5. (original): The method of claim 4, wherein the step of
2 decomposing comprises:
3 logically concatenating subsections of the body that is separated by
4 incorporated excerpts; and

5 applying a weighted finite state machine to the result.

1 6. (original): The method of claim 4, wherein the step of
2 decomposing comprises:
3 building a weighted network using a weighted finite state grammar;
4 identifying the maximally weighted path through the network; and
5 traversing the maximally weighted path to identify the logical components
6 of the section.

1 7. (original): The method of claim 1, wherein the document includes
2 a compressed form of each of the messages.

1 8. (original): The method of claim 7, wherein each of the compressed
2 forms comprises non-extraneous parts of the primary text and abbreviated forms
3 of incorporated excerpts.

1 9. (original): The method of claim 1, wherein the document includes
2 a replies as annotations form for each of the messages.

1 10. (previously presented): A computer controlled display system
2 comprising:
3 a display for presenting e-mail threads on a viewing area of the display;
4 and
5 a processor that is adapted to identify the logical components of each
6 message in a thread, determine the relationships between each message in the
7 thread using the logical components, and generate a medium based upon the
8 determined relationships,
9 wherein the processor is adapted to remove any logical components that
10 are identified in each of the messages in the thread so that the generated medium
11 does not include the redundant logical components.

1 11. (canceled).

1 12. (original): The system of claim 10, wherein the processor is
2 adapted to generate a message tree that includes nodes that divide each message
3 into a main body and into excerpts from other messages and further into lowest-
4 level logical components.

1 13. (original): The system of claim 12, wherein the processor is
2 adapted to perform a top-down, recursive descent analysis to create nodes of the
3 message tree and to analyze divided extents using a weighted finite state machine.

1 14. (original): The system of claim 12, wherein the processor is
2 adapted to identify the maximally weighted path through the weighted finite state
3 machine, and to develop a sub tree by traversing the maximally weighted path.

1 15. (original): The system of claim 10, wherein the document includes
2 a compressed form of each of the messages.

1 16. (original): The system of claim 15, wherein each of the
2 compressed form contains non-extraneous parts of the primary text.

1 17. (original): The system of claim 10, wherein the document includes
2 a replies as annotations form for each of the messages.

1 18. (previously presented): An information storage media comprising:
2 information that presents e-mail threads on a viewing area of a display;
3 information that identifies the logical components of each of the messages
4 in a thread;
5 information that determines relationships between each of the messages in
6 the thread using the logical components;
7 information that generates a medium based upon the determined
8 relationships; and

9 information that removes any logical components that are identified in
10 each of the messages in the thread so that the generated medium does not include
11 the redundant logical components.

1 19. (canceled).

1 20. (original): The information storage media of claim 18, further
2 comprising information that generates a message tree that includes nodes that
3 divide each message into a main body and into excerpts from other messages and
4 further into lowest-level logical components.

1 21. (original): The information storage media of claim 18, further
2 comprising:
3 information that performs a top-down, recursive descent analysis to create
4 some nodes of the message tree; and
5 information that analyzes divided extents using a weighted finite state
6 machine.

1 22. (original): The information storage media of claim 21, further
2 comprising;
3 information that identifies a maximally weighted path through the
4 weighted finite state machine; and
5 information that develops a sub tree by traversing the maximally weighted
6 path.

1 23. (original): The information storage media of claim 18, wherein the
2 medium includes a compressed form of each of the messages.

1 24. (original): The system of claim 23, wherein each of the
2 compressed form contains non-extraneous parts of the primary text.

1 25. (original): The system of claim 18, wherein the medium includes a
2 replies as annotations form for each of the messages.

1 26. (previously presented): A computer system for presenting email
2 threads comprising a computer processor for: (a) identifying logical components
3 of each message in a thread; (b) determining relationships between the messages
4 in the thread using the logical components; and (c) generating a medium based
5 upon the determined relationships, wherein the e-mail threads are presented in the
6 medium as semi-connected text, and wherein any logical components that are
7 identified in each of the messages in the thread are removed during the generating
8 step so that the generated medium does not include the redundant logical
9 components.

1 27. (original): The system of claim 26, wherein the medium is one of a
2 human readable document and a computer readable document.

11. EVIDENCE APPENDIX

None.

12. RELATED PROCEEDINGS APPENDIX

None.